IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Lenka M. Jelinek

Serial No.:	09/812,472	Group Art Unit:	3713
Filed:	March 19, 2001	Examiner:	C. Saadat
FOR:	TOYS, SOFTWARE AND METHODS FOR PRESENTING PLAY SURFACES WITH DYNAMICALLY ADJUSTABLE IMAGES		

BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant submits this brief on appeal, thus perfecting the notice of appeal filed on October 20, 2003.

The headings and subject matter under rule 192 follow.

(1) **Real Party in Interest**

This case is assigned of record to Intel Corporation, who is the real party in interest.

(2) **Related Appeals and Interferences**

There are no known related appeals and / or interferences.

(3) **Status of Claims**

Claims 1-32 are pending in the case and stand rejected.

(4) **Status of Amendments**

No amendments have been made after the final rejection.

(5)   **Summary of Invention**

The pending claims recite features directed to a toy set having a panel with a surface adapted to simulate a wall of a play environment. Examples of simulated surfaces described in the specification include wallpaper, a brick wall, and floor surfaces, among other simulated surfaces of structures which might be found in a play environment. The claims further recite a display associated with the panel which displays image data which is distinct from the simulated wall surface. For example, the image data enhances the play environment. For example, the image data may correspond to a window, or a fireplace, or an outdoor scene.

(6)   **Issues**

I.   The rejection of claims 1-2, 4-11, 14-18, 20-21, 23, and 25-32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,853,327 (Gilboa) in view of U.S. Patent No. 6,227,931 (Shackelford) is in error.

II.   The rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,853,327 (Gilboa) in view of U.S. Patent No. 6,227,931 (Shackelford), further in view of U.S. Patent No. 5,647,746 (Caspescha) is in error.

III.   The rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,853,327 (Gilboa) in view of U.S. Patent No. 6,227,931 (Shackelford), further in view of U.S. Patent No. 6,459,418 (Comiskey) is in error.

IV.   The rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,853,327 (Gilboa) in view of U.S. Patent No. 6,227,931 (Shackelford), further in view of U.S. Patent No. 6,190,174 (Lam) is in error.

V.   The rejection of claim 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,853,327 (Gilboa) in view of U.S. Patent No. 6,227,931 (Shackelford), further in view of GB 2 271 742 A (Baxter) is in error.

VI.   The rejection of claims 19 and 24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,853,327 (Gilboa) in view of U.S. Patent No. 6,227,931 (Shackelford), further in view of U.S. Patent No. 6,102.397 (Lee) is in error.

(7)   Grouping of the Claims

Group I: Claims 1, 2, 4, 5, 7-8, 14-19, 20-22, 23, 25, 28 and 32 stand or fall

together.

Group II: Claim 6 stands or falls on its own.

Group III: Claim 9 stands or falls on its own.

Group IV: Claims 10-11, 26 and 30 stand or fall together.

Group V: Claims 27 and 31 stand or fall together.

Group VI: Claim 3 stands or falls on its own.

Group VII: Claim 12 stands or falls on its own.

Group VIII: Claim 13 stands or falls on its own.

Group IX: Claim 24 stands or falls on its own.

(8)   Argument

I.   The rejection of claims 1-2, 4-11, 14-18, 20-21, 23, and 25-32 under 35 U.S.C. §
       103(a) as being unpatentable over U.S. Patent No. 5,853,327 (Gilboa) in view of
       U.S. Patent No. 6,227,931 (Shackelford) is in error.

With respect to Group I, claims 1, 2, 4, 5, 7-8, 14-18, 20-21, 23, 25, 28 and 32:

Each of independent claims 1, 25 and 29 recite features directed to a toy set
having a panel with a surface adapted to simulate a wall of a play environment.
Examples of simulated surfaces described in the specification include wallpaper, a brick
wall, and floor surfaces, among other simulated surfaces of structures which might be
found in a play environment. The claims further recite a display associated with the
panel which displays image data which is distinct from the simulated wall surface. For
example, the image data enhances the play environment. For example, the image data
may correspond to a window, or a fireplace, or an outdoor scene. Neither of the cited
references, individually or in combination, disclose these claim features.

The office action admits, as did the Examiner during the personal interview, that
Gilboa fails to disclose these claim features. The office action relies on Shackelford for

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the missing teachings. However, Shackelford also fails to disclose the recited features. Accordingly, the office action fails to establish a prima facie case of obviousness.

The office action cites col. 11, lines 37-43 for disclosing the missing teaching. However, the cited portion of the references merely describes an LCD which displays the time, like an LCD watch. The description fall far short of disclosing the recited display associated with a simulated wall surface for displaying image data.

Moreover, the office action fails to provide proper motivation to combine the references. The office action asserts that one skilled in the art would be motivated "to modify the display described in Gilboa, by attaching the display to a simulated wall" of a doll house. The only displays described in Gilboa appear to be conventional large CRTs typical of a personal computer system. It is simply incorrect that any one, skilled in the art or otherwise, would be motivated to attach a large CRT to a simulated wall of a doll house.

The office action ignores both the claim as a whole and the proper, if any, combination of the references. The claims as a whole describe an interactive play environment wherein a simulated play surface has an associated display which cooperates with the play surface to enhance the play. Gilboa describes a computerized game board, wherein a personal computer is utilized to display images which are not related to any simulated play surface. The Examiner agreed as much during the personal interview. Shackelford describes an interactive play environment which is conceptually completely different from Gilboa. The LCD display in Shackelford is not a integral part of the play experience and does not display image data, as that term is used in the claims. Applicants submit that the references do not lend themselves to any clear combination and one skilled in the art would not be motivated to modify Gilboa as suggested by the office action. Assuming for the sake of argument that the references might be combined, at most one skilled in the art might be motivated by Shackelford to add real time clock data to the personal computer display of Gilboa. However, this combination does not render the claims unpatentable.

Because the office action fails to establish a prima facie case of obviousness, and further because one skilled in the art would not be motivated to combine the references in the manner suggested in the office action, claims 1, 25 and 29 are patentable over Gilboa

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in view of Shackelford. Claims 2-24 depend either directly or indirectly from claim 1 and are likewise patentable. Claims 26-28 depend either directly or indirectly from claim 25 and are likewise patentable. Claims 30-32 depend either directly or indirectly from claim 29 and are likewise patentable.

The claims of Groups II-IX are further separately patentable for at least the reasons given below.

With respect to Group II, claim 6:

Claim 6 depends either directly or indirectly from claim 1 and is therefore patentable for at least the reasons given above in connection with Group I. Claim 6 is separately patentable for at least the following reasons.

Claim 6 recites the first set of image data is one of a plurality of sets stored in a memory. The office action relies on inherency for storing image data in memory. However, the office action fails to address the other recited aspects of claim 6. Accordingly, the office action fails to establish a prima facie case of obviousness with respect to claim 6 and the rejection of claim 6 should be reversed.

With respect to Group III, claim 9:

Claim 9 depends either directly or indirectly from claim 1 and is therefore patentable for at least the reasons given above in connection with Group I. Claim 9 is separately patentable for at least the following reasons.

Claim 8 recites a stand-alone controller to transmit the first set of image data to the first display. Claim 9 depends from claim 8 and recites that the stand-alone controller is to adapted to receive inputs from a personal computer. Gilboa describes only a PC based display while Shackelford describes only a stand-alone interactive play environment. The Examiner has not provided anything other a contrived motivation to combine the references, purportedly "to modify the controller described in Gilboa, by providing a stand-alone controller that accepts user input." However, the system described in Gilboa is a PC-based system which has the standard user input features of a keyboard and a mouse. No one, skilled in the art or otherwise, would be motivated to add a stand-alone controller for user input to the PC based system of Gilboa.

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The Examiner has impermissibly utilized the claim as a blueprint to pick and choose pieces of the prior art without providing proper motivation to modify the references as suggested.

Because no one skilled in the art would be motivated to modify Gilboa as suggested in the office action, claim 9 is separately patentable over Gilboa in view of Shackelford.

With respect to Group IV, claims 10-11, 26 and 30:

Claims 10-11 depend either directly or indirectly from claim 1, claim 26 depends from claim 25, and claim 30 depends from claim 29, and are therefore patentable for at least the reasons given above in connection with Group I. Claims 10-11, 26 and 30 are separately patentable for at least the following reasons.

Claims 10-11, 26 and 30 recite features generally directed to wirelessly transmitting image data to the display. The office action relies on col. 4, lines 15-29 for disclosing these claimed features. However, the cited portion describes only transmitting data from game pieces and has nothing to do with transmitting image data.

Accordingly, the office action fails to establish a prima facie case of obviousness with respect to claims 10, 11, 26 and 30, and the rejection should be reversed.

With respect to Group V, claims 27 and 31:

Claims 27 and 31 depend either directly or indirectly from claims 25 and 29, respectively, and are therefore patentable for at least the reasons given above in connection with Group I. Claims 27 and 31 are separately patentable for at least the following reasons.

Claims 27 and 31 recite choosing the first set of image data from a plurality of sets of image data depending on the output of the detector. The office action relies on col. 3, lines 19-29 for disclosing the recited features. However, the cited portion only generally describes displaying an audio visual sequence and does not even mention choosing one set of image data from a plurality of sets of image data.

Accordingly, the office action fails to establish a prima facie case of obviousness with respect to claims 27 and 31, and the rejection should be reversed.

II.   The rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,853,327 (Gilboa) in view of U.S. Patent No. 6,227,931 (Shackelford), further in view of U.S. Patent No. 5,647,746 (Caspescha) is in error.

With respect to Group VI, claim 3:

Claim 3 depends either directly or indirectly from claim 1 and is therefore patentable for at least the reasons given above in connection with Group I. Caspescha, which is relied upon for other aspects, fails to make up for the deficiencies of Gilboa and Shackelford. Claim 3 is separately patentable for at least the following reasons.

Caspescha describes a plush computer toy, and is non-analogous art with respect to both Gilboa and Shackelford. The Examiner has not provided anything other a contrived motivation to combine the references.

The Examiner has impermissibly utilized the claim as a blueprint to pick and choose pieces of the prior art without providing proper motivation to modify the references as suggested.

Because no one skilled in the art would be motivated to modify Gilboa and / or Shackelford as suggested in the office action, claim 3 is separately patentable over Gilboa in view of Shackelford, further in view of Caspescha.

III.   The rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,853,327 (Gilboa) in view of U.S. Patent No. 6,227,931 (Shackelford), further in view of U.S. Patent No. 6,459,418 (Comiskey) is in error.

With respect to Group VII, claim 12:

Claim 12 depends either directly or indirectly from claim 1 and is therefore patentable for at least the reasons given above in connection with Group I. Comiskey, which is relied upon for other aspects, fails to make up for the deficiencies of Gilboa and Shackelford. Claim 12 is separately patentable for at least the following reasons.

Comiskey describes electronic ink, but is otherwise is non-analogous art with respect to both Gilboa and Shackelford. The Examiner has not provided anything other a contrived motivation to combine the references.

Comiskey does not describe every possible application for electronic ink displays and does not teach or suggest the use of such displays in an interactive play set environment.

The Examiner has impermissibly utilized the claim as a blueprint to pick and choose pieces of the prior art without providing proper motivation to modify the references as suggested.

Because no one skilled in the art would be motivated to modify Gilboa and / or Shackelford as suggested in the office action, claim 12 is separately patentable over Gilboa in view of Shackelford, further in view of Comiskey.

IV.   The rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,853,327 (Gilboa) in view of U.S. Patent No. 6,227,931 (Shackelford), further in view of U.S. Patent No. 6,190,174 (Lam) is in error.

With respect to Group VIII, claim 13:

Claim 13 depends either directly or indirectly from claim 1 and is therefore patentable for at least the reasons given above in connection with Group I. Lam, which is relied upon for other aspects, fails to make up for the deficiencies of Gilboa and Shackelford. Claim 13 is separately patentable for at least the following reasons.

Lam describes only two indicator LEDs. Claim 13, read as a whole, is directed to a display which is capable of receiving and displaying image data, which includes light emitting diodes.

Accordingly, the office action fails to establish a prima facie case of obviousness with respect to claim 13, and the rejection should be reversed.

V.   The rejection of claim 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,853,327 (Gilboa) in view of U.S. Patent No. 6,227,931 (Shackelford), further in view of GB 2 271 742 A (Baxter) is in error.

Claim 22 depends either directly or indirectly from claim 1 and is therefore patentable for at least the reasons given above in connection with Group I. Baxter, which is relied upon for other aspects, fails to make up for the deficiencies of Gilboa and Shackelford. Claim 22 is not separately argued.

VI.   The rejection of claims 19 and 24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,853,327 (Gilboa) in view of U.S. Patent No. 6,227,931 (Shackelford), further in view of U.S. Patent No. 6,102.397 (Lee) is in error.

Claim 19 depends either directly or indirectly from claim 1 and is therefore patentable for at least the reasons given above in connection with Group I. Lee, which is relied upon for other aspects, fails to make up for the deficiencies of Gilboa and Shackelford. Claim 19 is not separately argued.

With respect to Group IX, claim 24:

The office action admits that neither Gilboa nor Shackelford discloses the recited claim features. The office action essentially admits that even Lee fails to disclose the recited second display, relying instead on a general interpretation that Lee purportedly describes "various forms of image data" (see final office action, page 10, line 4). Accordingly, the office action fails to establish a prima facie case of obviousness and the rejection should be reversed.

Moreover, the office action provides only a contrived motivation to modify the primary references or otherwise combine the references. The entire passage relied upon by the office action is as follows: " First, the CPU 14 can generate images and messages on the display screen 28 for the players to read. The display screen 28 can show the game board, the status of the game, rules, current playing status and the like." See col. 3,

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lines 61-62 of Lee. This description provides no motivation whatsoever for modifying Gilboa to include a second display.

Because the office action fails to establish a prima facie case of obviousness, and further because one skilled in the art would not be motivated to combine the references in the manner suggested in the office action, claim 24 is separately patentable over Gilboa in view of Shackelford, further in view of Lee.
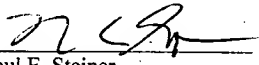
In view of the foregoing, favorable reconsideration and reversal of the rejections is respectfully requested. Early notification of the same is earnestly solicited. If there are any questions regarding the present application, the Examiner and / or the Board is invited to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

December 22, 2003
Date

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on:

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APPENDIX OF CLAIMS

1.   A toy set comprising:

at least one panel having a first surface, the first surface adapted to simulate a wall to use with a toy figurine; and

a first display that is to be attached to the first surface, the first display adapted to receive a first set of image data, and to display a first image responsive to the first set of image data,

wherein the image data is distinct from the wall simulated on the first surface of the panel.

2.   The toy set of claim 1, wherein

the panel has a data connection, and

the display receives the first set of image data through the data connection.

3.   The toy set of claim 1, wherein

at least one Velcro™-type strip is adapted to attach the first display to the panel.

4.   The toy set of claim 1, wherein

the display and the panel have at least one protrusion and mating opening, and

attachment is by placing the protrusion in the mating opening.

5.   The toy set of claim 1, wherein

the first set of image data is derived from one of a television signal, a streaming video signal, a video camera, and a global computer network.

6.   The toy set of claim 1, wherein

the first set of image data is one of a plurality of sets stored in a memory.

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7.   The toy set of claim 1, further comprising:

a toy figurine having a theme related to a theme of the first image.

8.   The toy set of claim 1, further comprising:

a stand-alone controller to transmit the first set of image data to the first

display.

9.   The toy set of claim 8, wherein

the stand-alone controller is to adapted to receive inputs from a personal

computer.

10.   The toy set of claim 1, further comprising:

a transmitting antenna to transmit the first set of image data; and

a receiving antenna to receive the transmitted first set of image data, the

receiving antenna adapted to be coupled to an input of the display.

11.   The toy set of claim 10, wherein

the receiving antenna is within the panel.

12.   The toy set of claim 1, wherein

the display displays the first image using electronic printed ink.

13.   The toy set of claim 1, wherein

the display includes light emitting diodes.

14.   The toy set of claim 1, wherein

the display includes a screen.

15.   The toy set of claim 14, wherein

the screen is one of a color screen and a liquid crystal display screen.

16. The toy set of claim 1, further comprising:

a light source.

17. The toy set of claim 1, further comprising:

a speaker.

18. The toy set of claim 1, further comprising:

a detector,

wherein the first set of image data is responsive to an output of the

detector.

19. The toy set of claim 18, wherein

the detector is a light sensor.

20. The toy set of claim 18, further comprising:

a lamp,

wherein the lamp is controlled responsive to an output of the detector.

21. The toy set of claim 18, wherein

the detector is to detect one of a location or an identity of the toy figurine.

22. The toy set of claim 18, wherein

the detector is a pressure sensor associated with a bottom panel to sense a

weight of the toy figurine.

23. The toy set of claim 18, wherein

the toy figurine includes a RF transponder, and

the detector includes an antenna to detect a return signal from the RF

transponder.

24.   The toy set of claim 1, further comprising:

a second display adapted to receive a second set of image data, and to display a second image corresponding to the second set of image data.

25.   An article comprising: a storage medium, said storage medium having stored thereon instructions, that, when executed by at least one device, result in:

waiting to receive a signal output from a detector indicative of a toy figurine characteristic; and

if the signal is received, transmitting a first set of image data to a display associated with a panel to cause the display to display an image corresponding to the first set of image data,

wherein the panel is adapted to provide a first surface which simulates a wall to use with the toy figurine and the image data is distinct from the wall simulated on the first surface of the panel.

26.   The article of claim 25, wherein

transmitting is performed wirelessly.

27.   The article of claim 25, wherein the instructions further result in:

choosing the first set of image data from a plurality of sets of image data depending on the output of the detector.

28.   The article of claim 25, wherein the instructions further result in:

transmitting a detection signal to a RF transponder of the toy figurine.

29.   A method comprising:

providing a panel having a first surface which simulates a wall to use with a toy figurine;

waiting to receive an output of a detector about a location of the toy figurine; and

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if the output is received, transmitting a first set of image data to a display associated with the panel to cause the display to display an image corresponding to the first set of image data, wherein the image data is distinct from the wall simulated on the first surface of the panel.

30.   The method of claim 29, wherein transmitting is performed wirelessly.

31.   The method of claim 29, further comprising:

choosing the first set of image data from a plurality of sets of image data depending on the output of the detector.

32.   The method of claim 29, wherein the detector is an antenna, and further comprising:

transmitting a detection signal to a RF transponder of the toy figurine.